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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,053	11/19/2003	David Charles Lyons	12929.1123US01	9304
7590 12/15/2004 Merchant & Gould P.C. P.O. Box 2903 Minneapolis, MN 55402-0903			EXAMINER COCKS, JOSIAH C	
			ART UNIT 3749	PAPER NUMBER

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/718,053

Applicant(s)

LYONS ET AL.

Examiner

Josiah Cocks

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-43 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/23/04 & 4/14/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. This application filed under former 37 CFR 1.60 lacks the necessary reference to the prior application. Applicant has included a priority statement but has not identified the parent application by serial number. Applicant should amend this statement to include the serial number.

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." (see applicant's specification, pages 8 and 13). Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

3. The drawings filed 11/19/2003 are accepted by the examiner.

Specification

4. The specification is objected to because applicant has identified a prior application in the specification but has not identified this application with a serial number (see applicant's specification, p. 13).

Claim Objections

5. Claim 43 is objected to because of the following informalities: In claim 43, line 2, it appears "hole" should read --holes--. Appropriate correction is requested.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 recites the limitation "the continuous panel" in line 2. There is insufficient antecedent basis for this limitation in the claim. As best can be determined, and for the purpose of an examination on the merits, it appears applicant intended to recite "a continuous panel."

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 38 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,542,407 to Hawkinson ("Hawkinson '407").

Hawkinson '407 discloses the invention as described in applicant's claim 38. In particular, Hawkinson '407 shows in Fig. 3 a method of assembling a fireplace including the step of positioning the combustion chamber (118) inside a combustion air enclosure and securing a glass panel (122) to the combustion chamber enclosure.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 1, 2, 5-7 and 17-22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 6,138,667 to Cakebread ("Cakebread").

Cakebread discloses in Figures 1-8 the invention substantially as described in applicant's claims 1, 2, 5-7 and 17-22. In particular Cakebread discloses a fireplace assembly including a combustion chamber enclosure (22) having top, bottom and side panels (see Fig. 3), an outer enclosure (12), and fireplace controls in the form of a gas valve and control unit attached to the bottom surface of a bottom panel (34) and disposed within the outer enclosure (See Figs. 2 and 4). Cakebread also discloses a combustion air enclosure (44) between the combustion chamber enclosure and the outer enclosure (see Fig. 2). In regard to the method claims 17-22 and 28, Cakebread is considered to disclose the method of manufacturing recited in these claims including coupling a glass panel (40) to the front surface of the combustion chamber enclosure (see Fig. 3), and matching the patterns of the side panel and the combustion chamber enclosure (see Fig. 3).

In regard to the recitation in the claim 1 of an access panel and claim 19 of a removable panel, the examiner considers that panel housing the grill assembly (38) would inherently be removable/provide access in order to access the controls beneath bottom panel (34) of the combustion chamber enclosure.

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13. Claims 3, 4, 28-34, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cakebread, as applied to claims 1 and 17 above, in view of U.S. Patent No. 5,542,407 to Hawkinson ("Hawkinson '407").

Cakebread teaches all the limitations of claims 3, 4, 28-34, and 37, except that the combustion chamber enclosure extends around substantially all of the outer surface of at least two panels or the side panel of the combustion chamber enclosure or around substantially an entire outer surface of the combustion chamber.

Hawkinson '407 teaches a fireplace in the same field of endeavor as Cakebread. In Hawkinson '407, a combustion air plenum covers the side top and bottom panels of a combustion chamber enclosure (see Fig. 3).

Therefore, in regard to claims 3, 4, 28-34, and 37 it would have been obvious to modify the combustion air enclosure of Cakebread to be configured as shown in Hawkinson '407 as this arrangement allows for supplying combustion air for a gas burner assembly in a manner that cools side panes of the fireplace and reduces the risk of burning to a room occupant (see Hawkinson '407, col. 3, lines 8-34).

14. Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cakebread in view of Hawkinson '407, as applied to claim 29 above, and further in view of U.S. Patent No. 6,170,481 to Lyons et al. ("Lyons").

Cakebread in view of Hawkinson '407 teach all the limitations of claims 35 and 36 except possibly the combustion air enclosure is molded as a single piece or include panels formed as a single piece.

Lyons teaches a fireplace in the same field of endeavor as Cakebread. In Lyons, the combustion chamber of the fireplace is formed from vacuum molding as a single piece using a ceramic fiber and a binder (RCF material) (see Lyons, col. 9, lines 42-63).

Therefore, in regard to claims 35 and 36, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combustion chamber of Cakebread to be vacuum molded forming a ceramic fiber with binder panel as vacuum molding in a single piece is understood in the art to produce a rigid fireplace box (see Lyons, col. 9, lines 60-63) and a ceramic fiber and binder material is recognized to have desirable insulating properties with cost advantages (see Lyons, col. 6, lines 28-35).

15. Claim 9, 11, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cakebread as applied to claims 1 and 17 above.

In regard to claims 9 and 26, OFFICIAL NOTICE is taken that a brick design is traditional in fireplace combustion chamber surfaces. Alternatively, the examiner considers that to select a brick design is simply a matter of aesthetic design choice. Applicant has not disclosed that a brick design provides any advantage or solves a stated problem. One of ordinary skill in the art would have expected applicant's invention to perform equally well with the wall designs shown in Cakebread. Therefore, these claims are not considered to patentably distinguish over the prior art.

In regard to claim 11, to have located the fireplace controls on the side of the combustion chamber is also considered an obvious matter of design choice. Applicant has not disclosed that controls on the side provides any advantage or solves a stated problem. One of ordinary skill in

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the art would have expected applicant's invention to perform equally well with the bottom located controls shown in Cakebread. Therefore, this claim is not considered to patentably distinguish over the prior art.

16. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cakebread, as applied to claim 6 above, in view of U.S. Patent No. 5,613,487 to Hawkinson ("Hawkinson '487").

Cakebread discloses all the limitations of claim 10 except that the glass panel is retained to the combustion chamber with a spring biased member.

Hawkinson '487 teaches a fireplace in the same field of endeavor as Cakebread. In Hawkinson '487 a glass panel (58) is retained to the combustion chamber with a spring biased member (40).

Therefore, in regard to claim 10, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the fireplace of Cakebread to incorporate the spring biased member of Hawkinson '487 as this arrangement desirably serves to relieve pressure in the combustion chamber in the event of an explosion (see Hawkinson '487, col. 3, lines 57-61).

17. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cakebread, as applied to claim 1 above, in view of U.S. Patent 4,726,351 to Whittaker et al. ("Whittaker").

Cakebread discloses all the limitations of claim 12 except for a light source.

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Whittaker teaches a fireplace in the same field of endeavor as Cakebread. In Whittaker, the fireplace includes a lamp light source (52).

Therefore, in regard to claim 12, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the fireplace of Cakebread to incorporate the lamp of Whittaker as the lamp produces a desirable glow effect (see Whittaker, col. 4, lines 54-59).

18. Claims 13, 23, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cakebread, as applied to claims 1 and 26 above, in view of U.S. Patent Application Publication 2003/0019490 to Buffington ("Buffington").

Cakebread discloses all the limitations of claims 13, 23, and 27 except that the side and rear portions include a contoured surface to create an appearance of no back corners.

Buffington teaches a fireplace in the same field of endeavor as Cakebread. In Buffington, the fireplace is shown as arched (see Fig. 3). The examiner considers this arched surface to be the contoured surface as recited in applicant's claims.

Therefore, in regard to claims 13, 23, and 27, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the fireplace of Cakebread to incorporate the arched surface of Buffington as this produces a rounded contour that is aesthetically pleasing (see Buffington, col. 1, paragraphs 0005 and 0035).

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19. Claims 15, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cakebread, as applied to claims 1 and 17 above, in view of U.S. Patent No. 6,170,481 to Lyons et al. ("Lyons").

Cakebread teaches all the limitations of claims 15, 24, and 25 except possibly that the combustion chamber is formed from compression, injection, or vacuum molding forming a continuous panel using a ceramic fiber and a binder or a moldable ceramic.

Lyons teaches a fireplace in the same field of endeavor as Cakebread. In Lyons, the combustion chamber of the fireplace is formed from vacuum molding as a continuous panel using a ceramic fiber and a binder (RCF material) (see Lyons, col. 9, lines 42-63).

Therefore, in regard to claims 15, 24, and 25, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combustion chamber of Cakebread to be vacuum molded forming a ceramic fiber with binder panel as vacuum molding is understood in the art to produce a rigid fireplace box (see Lyons, col. 9, lines 60-63) and a ceramic fiber and binder material is recognized to have desirable insulating properties with cost advantages (see Lyons, col. 6, lines 28-35).

20. Claims 8, 16, and 39-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cakebread, as applied to claim 1 above, in view of U.S. Patent No. 4,913,131 to Peterson ("Peterson").

Cakebread discloses all the limitations of claims 8, 16, and 39-43, including a glass panel (40) with a glass frame and glass sheet (see Fig. 3), except possibly for a surround member or access panel with first and second side panels.

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Peterson teaches a fireplace in the same field of endeavor as Cakebread. In Peterson, the fireplace includes a surround member/access panel (see Fig. 3) with first and second side panels (43 and 44).

Therefore, in regard to claims 8, 16, and 39-43, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the fireplace of Cakebread to incorporate the surround member of Peterson as this member desirably provides a decorative front facing (see Abstract of Peterson).

Allowable Subject Matter

21. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

22. This action is made non-final. A THREE (3) MONTH shortened statutory period for reply has been set. Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

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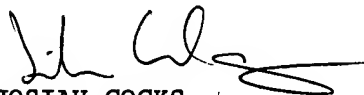
23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 5,471,973 and French Patent No. 2 650 371 are cited to further show the state of the art concerning fireplace structures.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Josiah Cocks whose telephone number is (571) 272-4874. The examiner can normally be reached on weekdays from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ira Lazarus, can be reached at (571) 272-4877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Any questions on access to the Private PAIR system should be directed to the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

jcc
December 12, 2004


JOSIAH COCKS
PRIMARY EXAMINER
ART UNIT 3749